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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,614	03/15/2004	John Larry Sanders	30621-DIV5-CIP1	2613

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EXAMINER	
PEZZUTO, HELEN LEE	
ART UNIT	**PAPER NUMBER**
1713	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/708,614	SANDERS ET AL.	
	Examiner	Art Unit	
	Helen L. Pezzuto	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/21/06 has been entered.

Response to Amendment

Applicant's amendment to claims 1, 19 filed in the response on 2/21/06 is acknowledged. In light of applicant's amendment and remarks, previous 112 and 103 rejections of record are hereby withdrawn. Claims 1-34 are pending in this application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schapira (US-476).

U.S. 5,472,476 to Schapira et al. discloses an anticlumping coating composition for fertilizers, comprising water-soluble polymers and a surface-active agent. Suitable water-soluble polymers taught include copolymers of maleic acid and acrylic acid, and salts thereof, thus fall within the scope of the recited dicarboxylic polymer being predominantly composed of moieties having at least two carboxylic units in the present claims (col. 2, lines 3-13). Suitable fertilizers include those expressed in the present claims(col. 2, line 54-60). Thus, rendering obvious the present claims.

4. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uraneck et al (US-583).

U.S. 3,070,583 to Uraneck et al. discloses a method for solubilizing an acid copolymer and the subsequent utility the resulting aqueous copolymer salt solution as coating for fertilizers (col. 1, lines 33-42; col. 3, lines 14-28). Prior art solubilized acid copolymer is derived from acidic monomers containing at least one carboxy group per molecule, copolymerized with one or more comonomer. These acidic monomers include dibasic acid such as maleic,

itaconic, fumaric within the scope of the instant dicarboxylic polymer (col. 2, lines 13-69; col. 3, lines 21-33). Prior art teaches that the resulting polymer must be water soluble (col. 3, lines 1-3, 60-65) and can be used as coating composition for fertilizers, thus, embraces the instant dicarboxylic polymer being in contact with the fertilizer product as expressed in the present claims. The recited "predominately" in claim 1 is expected in the prior art as patentees' goal was to solubilize an acidic copolymer containing multiple carboxy group. One having ordinary skill in the art would have readily envisaged using major amount of acidic monomers in the production of acidic copolymer. Furthermore, the present claims do not preclude comonomer in the prior art acidic copolymer. Suitable solublizing agent employed by patentees include alkali metal hydroxide, which is expected to inherently complexes with the carboxylate polymer to form a soluble salt solution (col. 1, lines 58-59). Accordingly, it would have been obvious to one having ordinary skill in the art to provide a coating of a substantially water-soluble dicarboxylic acid polymer onto a fertilizer product as taught, motivated by the reasonable expectation of success. Finally, the recited process steps are considered

conventional practice in free radical polymerization. One having ordinary skill in the art would have readily envisage using thermal free radical initiator and/or photo initiators to carry out the polymerization in suitable solvent medium under appropriate temperature/pressure conditions. It has been held that the optimization of known result oriented variables within the skill of the art to solve a known problem in a known process is obvious and involves only routine skill in the art, absent showing of unexpected results.

Double Patenting

5. Claims 1-3, 12-20, 29-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11, 23-34, 37-38 of copending Application No. 10/708,653. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims encompass the subject matter in co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-3, 12-20, 29-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as

being unpatentable over claims 15-25 of copending Application No. 10/708714. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are generic to and encompass those in the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen L. Pezzuto
Primary Examiner
Art Unit 1713

hlp